

## **REMARKS**

No amendments were made to the pending claims.

Claims 1-9, 11, 23-27, 29-39, 41, 42, and 55-61 remain pending in this application.

### **1. Response to Anticipation Rejection based upon Tobias**

In paragraphs 1 and 2 on pages 2-4 of the Action, the Patent Office rejected claims 1-4, 6-8, 11, 23-27, 29-38, 41, 42, and 55-57, 60 and 61 under 35 USC 102(b) as anticipated by U.S. Patent 5,115, 974 of Tobias, et al. [herein "Tobias"]. While the Applicant is pleased that the earlier anticipation rejection based upon Gardenier has been withdrawn, the Applicant respectfully submits that this rejection based upon Tobias is even more a field of the present invention than Gardenier and is clearly inappropriate. The Applicant requests that this rejection be reconsidered and withdrawn. Please see the Applicant's observations and comments below.

Again, as discussed in the Response dated June 24, 2005 (the disclosure of which is incorporated by reference herein in its entirety), MPEP § 2131 provides guidelines under which an anticipation rejection is appropriate (these are not repeated here for brevity). The Applicant respectfully submits that Tobias does not include "each and every element" of the invention recited in the amended claims, nor does Tobias show the invention "in as complete detail" as the amended claims.

With respect to the anticipation rejection of independent claims 1, 23, 30, and 35, the Applicant is at a loss to understand how the U.S. Patent Office can possibly consider the "coping" 16 of Tobias as a the claimed "seat" and the pool of Tobias as the claimed "foot well." The cited structures have absolutely nothing to do with the claimed invention and suggests that the Patent Office lacks a basic understanding of backyard swimming pools and their distinctions from the present invention.

As stated in Tobias, structure 16 is a "coping," not a "seat" or any type of structure that can be considered a "surface...on which a user can sit," as claimed by the Patent Office. By the reasoning proposed by the Patent Office any horizontal surface can apparently be a "seat" as claimed, for example, as the top surface of device 10 can be a "surface... on which a user can sit" and the top surface of pump 30 of Tobias or filter 32 can also be a "surface...which a user

can sit." Of course, such reasoning is nonsensical, these surfaces - as surface 16 - are not seats, especially not as disclosed in the present specification and recited in these claims.

Moreover, any child will attest to the fact that coping 16 is not a surface to be sat on. Children are often admonished to "keep off the edge" (that is, the coping) of backyard pools, such as shown in FIGURE 1, to avoid collapsing or otherwise damaging the structure of the pool. To one of skill in the art, coping 16 does not comprise a seat.

For this reason alone, these rejections are inappropriate. The Applicant requests that these rejections be reconsidered and withdrawn.

In the same manner, pool 12 of Tobias does not comprise a "foot well" as claimed and understood by those of skill the art. As clearly described and illustrated throughout the present Specification, a foot well, for example, foot well 52 in Figure 2, is a term of the art and comprises a cavity below a seat into which the feet of a seated bather can rest. The pool of Tobias is not a "foot well" as claimed. Again, the Applicant respectfully submits that, by identifying the "position below the elevation [of the coping 16]" of Tobias as a "foot well," the Patent Office is exhibiting a clear lack of understanding of the art of the present invention. Again, for this reason alone, these rejections are inappropriate. The Applicant requests that these rejections be reconsidered and withdrawn.

Further, the Patent Office has identified structures in Tobias as inlets that are not "inlets in a bathing enclosure" as claimed. In section 2, on page 2 of the Action, the Patent Office identified "spray inlets" 62 of Tobias as the claimed "water inlets in a bathing enclosure" and identified the "exit ports" 60 of Tobias as the claimed "outlets" of the manifold. However, the "spray inlets" 62 of Tobias, are not "in the bathing enclosure" as claimed. The spray inlets 62 are in the manifold 52 of Tobias; the spray inlets 62 are not "in the bathing enclosure," such as in pool 12 of Tobias. Again, for this reason alone, these rejections are inappropriate. The Applicant requests that these rejections be reconsidered and withdrawn.

Pursuant to MPEP § 2131, any one of these three distinctions from the claimed invention is sufficient to overcome an anticipation rejection under 102(b). However, that there are at least three distinctions underscores the inappropriateness of a rejection of claims 1, 23, 30, and 35 as anticipated by Tobias. The Applicant requests that these rejections be reconsidered and withdrawn.

With respect to the rejections of claims 2-4, 6-8, 11, 24-27, 29, 31-34, 36-38, 41, 42, 55-57, 60, and 61 as anticipated by Tobias, these rejections are inappropriate for the same reasons that the rejections of claims 1, 23, 30, and 35 from which they depend, are inappropriate. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

## **2. Response to Obviousness Rejection based upon Ruderian and Friend**

In paragraph 6 on pages 5-6 of the Action, the Patent Office rejected claims 1-4, 6-9, 11, 23-27, 29, 30, 32-38, 41, 42, and 55-61 under 35 USC 103(a) as obvious in view of the combined teachings of U.S. Patent 3,374,492 of Ruderian [herein "Ruderian"] and U.S. Patent 3,641,996 of Friend [herein "Friend"]. Again, the Applicant respectfully submits that these rejections are inappropriate. The Applicant requests that this rejection be reconsidered and withdrawn.

It is well established in the law that for a 35 USC 103 obviousness rejection to be appropriate there must be some form of teaching, suggestion, or motivation in the cited art to combine their teachings. Specifically, Section 2143.10 of the MPEP provides the following guidelines concerning the appropriateness of combining the teachings of prior art references:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) [Emphasis added.]

The Applicant submits that neither Ruderian, nor Friend, nor general knowledge in the art provide any teaching, suggestion, or motivation to combine their teachings to produce the present invention. In addition, the Applicant submits that the nature of the problem to be solved "as a whole" by the present invention does not suggest that the teachings of Ruderian and Friend be combined.

With respect to the rejection of independent claims 1, 23, 30, and 35, in the last paragraph on page 5 of the Action, the Patent Office identifies various structures in Ruderian

that the Patent Office claims correspond to the structures recited in these claims. However, the Applicant submits that the Patent Office has misinterpreted many of the structures illustrated by Ruderian. First, the Patent Office identified structure 25 in Ruderian as a "seat." However, examination of Ruderian discloses that structure 25 is a "step," not a seat (see 3: 21-23). As described by Ruderian,

These steps are designed to facilitate entry and exit from the bathtub and to help in supporting a user's body in various positions in the tub. For example, the person may lie substantially prone in the tub with his feet engaging either the first or second of the steps 24 and 25, depending upon his height. [Emphasis added.] (3:25-31)

Clearly, contrary to the comments made by the Patent Office, structures 24 and 25 are steps, not seats, as claimed. Steps 24 and 25 may be used to support the feet of the bather as the bather lies prone in the tub. For this reason alone, this rejection is inappropriate and should be withdrawn.

In the subsequent sentences, Ruderian states:

Alternately, the person may sit in the tub with his back resting against the second step 25, this step having a curved riser as shown for the comfort of the user. (3:31-34).

Should the Patent Office be tempted to identify this passage as supporting an interpretation of step 25 being the claimed "seat," the Applicant submits that the second step 25 is the lower step of the Ruderian tub. That is, the curved riser of the second step 25 is the lower vertical riser between the base of the tub and the surface of step 25. In other words, according to the above passage, the occupant would be sitting on the bottom of the tub with his or her back against the riser of step 25. Again, step 25 would not be functioning as a seat, but, again, as a step.

Also, contrary to the claimed invention, Ruderian does not include a foot well as claimed. As discussed above, Ruderian discloses a tub having steps and a bottom 16 onto which a bather lies in the prone position, or seated on the bottom 16 with his or her back against the riser of step 25. In neither position, does the tub of Ruderian have a foot well or any structure that functions as a foot well.

As acknowledged by the Patent Office in the first paragraph that appears on page 6 of the Action, in addition to failing to teach the above, Ruderian fails to include a diverter as claimed. The Patent Office then relies on the teachings of Friend to provide this missing teaching.

However, first, Friend does not provide the teachings missing from Ruderian. No seat or foot wells according to the present invention are disclosed by Friend.

Second, there is no teaching, suggestion, or motivation in Friend (or in Ruderian) to provide a valve 13 in Ruderian to provide the present invention. According to the Patent Office, Friend discloses a valve 13. However, like any prior art reference that discloses a valve, there is no suggestion in Friend where or how the valve can or should be positioned in Ruderian. There is absolutely no suggestion in Friend or in Ruderian that a valve 13 be positioned in the system of Ruderian to divert flow to the foot well as claimed. Clearly, the Patent Office is resorting to hindsight and using the Applicant's own disclosure as a basis for this rejection.

It is well established in the law that it is impermissible to use the Applicant's own disclosure as a basis for formulating a rejection under 35 USC 103. The second paragraph of MPEP 2142 instructs us in this regard.

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. [Emphasis added.]

The Applicant submits that the Patent Office has clearly transgressed this restriction when using the Applicant's disclosure as a basis for establishing this obvious rejection in view of Ruderian and Friend. Again, the Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Moreover, it is unclear to the Applicant how the valve 13 can be installed in the system of Ruderian and still be accessible by the user. As clearly shown in Figure 1 of Ruderian, the piping into which valve 13 is claimed to be installed is all concealed within the floor of bathroom 10 and inaccessible by the bather. Again, there is no teaching or suggestion in either reference

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how a valve such as valve 13 can be installed in one of the pipes of Ruderian and still be accessible by the bather.

For all these reasons, the Applicant submits that the inventions recited in claims 1, 23, 30, and 35 are not obvious in view of Ruderian and Friend. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

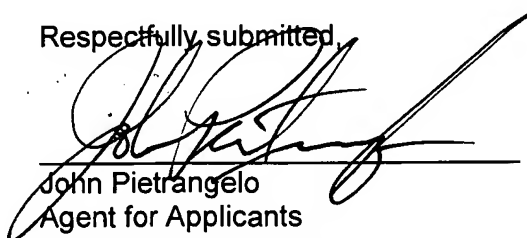
With respect to the rejection of dependent claims 2-4, 6-9, 11, 24-27, 29, 31-34, 36-39, 41, 42, and 55-61 as obvious in view of Ruderian and Friend, these rejections are inappropriate for the same reasons that the rejections of claims 1, 23, 30, and 35 from which they depend, are inappropriate. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

### **3. Conclusion**

The Applicant believes that the above remarks overcome the rejections of the subject Office Action. The Applicant believes that the application is in condition for allowance. An early and favorable action on the merits of the application is requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, the Applicant's undersigned Agent invites the Examiner to telephone him at the number provided.

Respectfully submitted,



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